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EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3629

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/720,927

Applicant(s)

GIL ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
2. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 120 is acknowledged.
3. The disclosure is objected to because of the following informalities:
 - A) it is noted that the 109 pages of paper appendices as filed October 04, 1996 does not comply with the requirements of 37 CFR § 1.96(c). Note that the paragraphs located:
 - (1) at page 1, lines 16-20, as amended on 23 January 2004, "Appendices A and B of Applicants' U.S. Pat. No. 5,586,037, are incorporated by reference herein."; and
 - (2) at page 9, lines 17-25, as amended on 13 February 1998, "The mailing system of the present invention is completely controlled via a computer (1308), as shown in Fig. 7, and a user-friendly, software program as illustrated in the flow charts (Figs. 11A-11B, 12A-12B, 13A-13B, 14A-14B, 15, 16A-16B & 17A-17B) and data flow diagrams (Figs. 19-23). Preferably, an I.B.M. compatible computer using an Intel 386 for the CPU, having a minimum 33 HZ clock speed, is employed. The inventive software is further defined by its source code, which is provided in the attached Appendix A."; and
 - (3) between page 15, line 9, and page 16, line 22, as amended on 13 February 1998, "The inventive system (100) most preferably comprises an automatic feed transport system (149) which is capable of automatically feeding the letter directly into the postage meter (211). As shown in Fig. 4A-4E, in particular Fig. 4A the automatic transport system (149) preferably comprises a series of rollers (149a) contained within a letter (150) platform Integral with the platform (150) is a meter strip plate (201) and an

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electronic letter weighing scale comprising a weigh plate (200) and a load cell (215). To weigh the letter, the user places the letter onto the weigh plate (200). The presence of the letter is then detected by an optical sensor (225). The load cell (215), which is connected to the computer (1308) via Analog to Digital weigh card (1202) and the software program, as shown in Figs. 6A-6C, will weigh the letter. However, the load cell will not weigh the letter until such time as the user has removed his or her hand. This is done by utilizing a software algorithm which will detect minute vibrations which are always present when a human being is touching a scale. The special weighing algorithm is also illustrated in its entirety in the attached appendices, specifically Appendix B. While the letter (L) is being weighed, the computer (1308) simultaneously checks to see if the postage meter (211) is in the correct position to accept the letter through the automatic feed system (149). The computer determines the postage meter position by particularly looking into the inputs of limit switch (209) and limit switch (204). If limit switch (204) is in the ON position, then the postage meter is in the correct position to accept the letter. In this case, the computer will activate linear actuator (207) which will move the translation table (216) to the forward (c) position (Fig. 4C). However, if the computer detects that limit switch (209) is in the ON position and limit switch (221) is in the OFF position, it will cause the linear actuator (207) to retract until such time as limit switch (221) will be in the ON position. This operation is particularly important as the postage meter (211) cannot be rotated in any other position but the backward position. All rotation of the postage meter (211) to the letter position (c) or the postage meter strip dispensing position (e), as shown Figs. 4C and 4E, respectively, must take place in the backward position in which linear actuator (207) is retracted (positions b and d as shown in Figs. 4B and 4D, respectively). Once this position is achieved, the computer will activate the rotation motor (202) to rotate the postage meter rotation table (203) which is supported on at least one rotation bearing (210)."; and

(4) at page 34, lines 7-8, "These functions are discussed in more detail below as well as in the source code provided in the attached Appendix A."

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Appropriate correction is required.

4. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

5. Claims 5-12 & 16-19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5.1 In regard to claims 5-12 & 16-19, although one of ordinary skill at the time of the invention would know how to accomplish each of the individual recited actions/functions from the language of these claims, since, there is no clear and definite interconnection between one or more of the recited limitations of these claims, one of ordinary skill could not determine from the language of these claims whether or not they are in fact making and/or using the claimed invention. In this regard it is noted that from the language of these claims it is vague, indefinite and unclear:

A) in regard to claim 5 and why the "means for weighing the item to be shipped" is included, since lines 7-10, "control means for analyzing the inputted information and calculating the fee for shipment of the item; said control means further including means for receiving credit card information and means for communicating and assessing the shipment fee to the account of the person owning the credit card, said means for communicating the shipment fee being by telephone lines;", does not require the weight to determine the shipping fee.

B) in regard to claim 5 and the inclusion of a "means for securely storing said item until the item is collected by said commercial delivery service;", since the system of claim 5 does not:

(1) include any means to accept an item so that it may be securely stored;

or

(2) an overall housing in which the recited means may be located or located adjacent to the “means for securely storing”.

C) in regard to claim 6 and where and how the “means for printing a hard copy of said manifest”, would fit into the system of claim 5, since the system of claim 5 does not produce a manifest.

D) in regard to claim 10 and why the “means for weighing the item to be shipped” is included, since lines 7-10, “control means for analyzing the inputted information and calculating the fee for shipment of the item; said control means further including means for communicating and assessing the shipment fee to the account of the person owning the credit card, said means for communicating the shipment fee being by telephone lines;”, does not require the weight to determine the shipping fee.

E) in regard to claim 10 and the inclusion of a “means for securely storing said item until the item is collected by said commercial delivery service;”, since the system of claim 10 does not:

(1) include any means to accept an item so that it may be securely stored;

or

(2) an overall housing in which the recited means may be located or located adjacent to the “means for securely storing”.

F) in regard to claims 11 & 18 and why a “shipping label” would be issued, since the systems of claims 10 & 16, respectively, do not require anything to be applied to the item to be shipped after the payment account has been validated.

G) in regard to claim 16 and why the “means for weighing the item to be shipped” is included, since lines 7-10, “control means for analyzing the inputted information and calculating the fee for shipment of the item; said control means further including means for communicating and assessing the shipment fee to the account of the person shipment fee to the account of the person, said means assessing comprising means for printing a hard copy of said account charge for said person;”, does not require the weight to determine the shipping fee.

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H) in regard to claim 16 and the inclusion of a “means for securely storing said item until the item is collected by said commercial delivery service;”, since the system of claim 16 does not:

(1) include any means to accept an item so that it may be securely stored;

or

(2) an overall housing in which the recited means may be located or located adjacent to the “means for securely storing”.

I) in regard to claim 19 and the inclusion of a “means for securely storing said item until the item is collected by said commercial delivery service;”, since the system of claim 19 does not:

(1) include any means to accept an item so that it may be securely stored;

or

(2) an overall housing in which the recited means may be located or located adjacent to the “means for securely storing”.

5.2 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

6. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

6.1 Claims 5-12 & 16-19 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

6.1.1 As set forth by the Court in:

A) In re Musgrave 167 USPQ 280 at 289-290 (CCPA 1970), “We cannot agree with the Board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing

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the process to think. All that is necessary, in our view, to make a sequence of operational steps a statutory "process" within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." Cons. Art. 1, sec. 8.", {emphasis added}; and

B) In re Sarkar 100 USPQ 132 @ 136-137 (CCPA 1978), echoing the Board of Appeals stated in regard to claim 14 "14. A method of locating an obstruction in an open channel to affect flow in a predetermined manner comprising:

a) obtaining the dimensions of said obstruction which affect the parameters of flow;

b) constructing a mathematical model of at least that portion of the open channel in which said obstruction is to be located in accordance with the method of claim 1 using those dimensions obtained in step (a) above;

c) adjusting the location of said obstruction within said mathematical model until the desired effect upon flow is obtained in said model; and thereafter

d) constructing said obstruction within the actual open channel at the specified adjusted location indicated by the mathematical model.";

and "Concerning claims 14-39 and the significance of "post-solution activity," like building a bridge or dam, the board concluded: While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute.", {emphasis added}.

6.1.2 Further, it is noted in regard to claims 14-39 of Sarkar, although step (d) of claim 14 of Sarkar references the result of step (c) of claim 14 of Sarkar it is clear from the language of step (c) of claim 14 of Sarkar that multiple adjustments to the location of the obstruction are

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required to be made until a location with the desired effect has been determined. Hence, the reference to constructing the obstruction at the "specified adjusted location" in step (d) of claim 14 of Sarkar is vague, indefinite and unclear in regard to which one of the possible multiple adjusted locations of the obstruction that were used during step (c) of claim 14 of Sarkar would be used when constructing the obstruction as required by step (d) of Sarkar. Therefore, without a clear connection between step (d) of Sarkar and the remaining steps of claim 14 of Sarkar, the Board of Appeals and the Court held that these claims were not a process within the meaning of process as used in 35 U.S.C. § 101 and hence were directed to non-statutory subject matter.

6.1.3 As can be seen from claims 5-12 & 16-19, these claims are directed to a series of devices for performing various functions or steps/actions/functions, which as set forth above in regard to the rejection of claims 5-12 & 16-19 under 35 U.S.C. § 112 2nd paragraph, are not clearly and definitely interconnected to one another and therefore do not provide an operative useful machine/system or method/process within the meaning of machine or process as used in 35 U.S.C. § 101.

6.2 Claims 1-19 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since:

A) in regard to claims 5-12 & 16-19, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 112 2nd paragraph as set forth above.

B) in regard to claims 1-19, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 102 as set forth below.

C) in regard to claims {fill in}, these claims fail to comply with the "requirements this title, namely 35 U.S.C. § 103 as set forth below.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has

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fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7.1 Claims 1-19 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Ramsden (5,481,464).

7.2 It is noted that:

A) the effective filing date for the subject matter of claims 5-12 & 16-19, i.e. the transmission of user data to a central location is the filing date of the instant application, that is August 02, 1994, while,

B) the effective filing date for the subject matter of claims 5-12 & 16-19, i.e. the transmission of user data to a central location as copied from Ramsden ('464) is February 18, 1994.

Hence, the invention of claims 1-19 was known to others before the filing by applicant.

8. Response to applicant's arguments.

8.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

8.2 In regard to the objection to the appendices, it is noted that if applicant wishes to incorporate the appendices from the parent patent, then applicant must cancel the 109 pages of appendices A & B that are still part of the instant application and there by remove the above objection and requirement.

8.3 As per the 35 U.S.C. § 102(e) rejection, since:

A) the text referred to by applicant to support the use of a credit card as payment is, (reproduced below):

(1) at page 1, lines 30-35 of the 07/678,863 application now serial number 07/994,182, "The machine obtains payment from the customer, notably through the use of a prepaid, low-cost charge card which may be sold in convenient denominations at the machine's location (e.g. at a convenience store). A magnetic card reader for handling such cards may be connected through a conventional interface directly to,

e.g., a convenience-store cash register. Alternatively, the customer may use a credit card to make payment.”; and

(2) at page 11, lines 1-6, of the 07/678,863 application now serial number 07/994,182, “The customer is able to request an electronic mail operation (e.g., using a conventional electronic mail service such as MCI Mail) using one of the two types of floppy disc drives 124, 126 by inserting a floppy disk into the drive and following the voice/touch screen 110 instructions. The customer is thereby able to transmit his files to another computer. The cost of the electronic mail is deducted from the prepaid magnetic card and the card is returned to the customer.”.

B) as can clearly be seen from these passages of the 07/678,863 application now serial number 07/994,182, these passages merely enables one of ordinary skill to implement an invention that:

(1) preferably uses an inserted pre-purchased **PREPAID MAGNETIC CARD** that contains a monetary value as the source of payment;

(2) permits the loading of electronic mail data or electronic data files;

(3) permits the transmitting/receiving of electronic mail data or electronic data files to/from a remote location;

(4) deducts the cost of transmitting/receiving the electronic mail data or electronic data files from the available monetary value that has been stored in/on the inserted **PREPAID MAGNETIC CARD**;

(5) returns the inserted **PREPAID MAGNETIC CARD** to the owner of the card with the remaining monetary value; and

(6) **merely makes a suggestion that a credit card may be used as the source of payment, but clearly fails to provide an adequate written description that includes an enabling disclosure that would either to teach or suggest to one of ordinary skill at the time of the invention how the above system, that is invention described in abandoned application serial number**

07/678,863 application now serial number 07/994,182 that is directed to using prepaid cards as the source of payment could or would be modified to implement the use of credit card as the source of payment.

C) in view of the above teachings, it can not be seen how the above quoted text from the 07/678,863 application now serial number 07/994,182 would enable one of ordinary skill to:

(1) in regard claims 1-9 & 13-15, to either:

(a) use a credit card, (note also claim 8); or

(b) insert a credit card, which is recognized as being functionally different than a **PREPAID MAGNETIC CARD**, i.e. a debit card, because a credit card does not store a monetary value; or

(c) insert a credit card, which is recognized as requiring a payment process that is functionally different than the payment process for a **PREPAID MAGNETIC CARD**, i.e. a debit card, because a credit card does not store a monetary value; or

(d) the transmit credit data to a remote location for billing the customer, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from the payment system.

(2) in regard to claim 7 to:

(a) transmit shipping manifest data to a remote location, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from a manifesting system.

Since, in the 07/678,863 application now serial number 07/994,182, only the electronic mail data or electronic data files is transmitted and while the manifest data is stored at the "Automated Self-Service Package Shipping Machine".

(3) in regard claims 10-12 to either:

(a) transmit shipping fee data to a remote location for billing the customer, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from the payment system.

(4) in regard to claims 16-18 to:

(a) use a customer's account for billing the shipping fee, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from the payment system.

(5) in regard to claim 17 to:

(a) transmit shipping fee data to a remote location for billing the customer, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from the payment system.

(6) in regard to claims 9, 11 & 18 to:

(a) validate the credit card before issuing a shipping label for the customer, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from the payment system.

(7) in regard claim 19 to either:

(a) transmit shipping fee data to a remote location for billing the customer, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from the payment system; or

(b) transmit shipping manifest data to a remote location, since as taught and suggested in the 07/678,863 application now serial number 07/994,182, the transmitted data/information does not originate from the manifesting system.

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Since, in the 07/678,863 application now serial number 07/994,182, only the electronic mail data or electronic data files is stored at the "Automated Self-Service Package Shipping Machine".

8.3.1 Further in regard to the 35 U.S.C. § 102(e) rejection, since, the payment processing required for either a credit card or debit card transaction as is well known is quite different and more extensive than the payment processing required for a prepaid card, which stores the remaining balance, the merely making a brief mention by applicant that payment could be made by credit card fails to provide the support required to enable the invention as now claimed. Note in regard to finding support within the disclosure for the claimed invention, applicant is reminded that "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

8.4.2 It is further noted that applicant failed to make an incorporation by reference to the disclosures of the parent applications. Therefore those disclosures do not form part of the instant disclosure, hence, applicant may not rely on any external disclosure in order to provide essential support for the presently claimed subject matter.

8.4.3 Hence, applicant's argument's are non persuasive.

9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

10.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

01/08/05



Edward R. Cosimano
Primary Examiner A.U. 3629